

REMARKS

I. Status of Claims

Upon entry of this amendment: claims 1-13 and 15-43 are pending in this application; claims 1, 13, 15, 20 and 38 are amended; claim 14 is cancelled; claims 39-43 have been added; and claims 27-37 are withdrawn.

Claims 1-26 and 38 have been rejected. Claims 27-37 have been withdrawn from consideration by the Office as being drawn to non-elected subject matter.

II. Election/Restriction

Applicant elects, with traverse, to prosecute Group I, claims 1-26 and 38, drawn to layered materials. Applicant believes that a search involving claims 27-37 could be done without any undue burden on the Examiner. See M.P.E.P. § 808.02, (Rev. 3, October 2005). Withdrawal of the restriction requirement is accordingly requested.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-27 and 38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. US 2003/0001108 A1 ("*Rangwalla*") in view of U.S. Patent No. 5,382,282 ("*Pennaz*"). The Examiner alleges that *Rangwalla* discloses a packaging material comprising a substrate, an ink print layer and a lacquer overcoat. (*Office Action* at 3.) The Examiner admits that *Rangwalla* does not disclose the claimed ink formulation, but contends that one would have been motivated to combine the ink composition taught by *Pennaz* to arrive at the claimed composition with "enhanced water stability." (*Id.* at 3-4.) Applicant respectfully disagrees, and traverses this rejection for at least the following reasons.

A. The Examiner Has Failed To Establish A *Prima Facie* Case Of Obviousness Over Rangwalla and Pennaz

The Examiner has the burden of pointing to some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify the reference or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Even though individual components of the presently claimed invention may be found separately in the references of record, merely identifying all of the claimed elements in the prior art, as the Examiner has allegedly accomplished here, is not sufficient to establish a *prima facie* case of obviousness. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (citations omitted) (“[m]ost if not all inventions arise from a combination of old elements However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.”)

As acknowledged by the Examiner, *Rangwalla* fails to teach or suggest the recited ink formulations as presently claimed. To remedy this deficiency, the Examiner relies upon *Pennaz*. *Pennaz* allegedly teaches a radiation curable ink composition comprising ink, oligomers and/or monomers, and a water reducible resin component. (See *Pennaz* at col. 19, ll. 47-63.) The alleged point of novelty appears to be the resin (*Id.* at col. 4, ll. 46-66.) The resin’s water solubility is a function of pH, and it is present in the ink composition in its unneutralized form to render the composition initially water insoluble. (*Id.*) However, upon change in pH, the resin is reduced and allows the ink to

be washed away or cleaned up. (*Id.* at col. 22, lines 46-53.) Thus, ink compositions taught in *Pennaz* have the property of being able to be removed as a function of the pH of the water introduced to the ink composition. (*Id.*) The water reducible resin component is thus central to the teachings of *Pennaz*.

While the present claims do not exclude the presence of a water reducible resin like the one used in *Pennaz*, *Pennaz* does not teach or suggest that such a water reducible resin containing ink composition could be used in the invention described in *Rangwalla* in place of the *Rangwalla* ink composition. The ink compositions of *Pennaz* relied upon by the Examiner are described as “[c]onventional radiation curable ink compositions,” col. 19, ll. 49-50, but are used in combination with the disclosed water reducible resin.

Nothing in *Pennaz* suggests that the described ink compositions, including the resin, could be used in a layered material comprising a substrate, an ink layer and an over print varnish, like that described in *Rangwalla*. Indeed, there is no evidence that an “ink composition having enhanced water stability and viscosity,” O.A. at 4, would work in the disclosed *Rangwalla* invention, as alleged by the Examiner. This shortcoming is even more acute here because of the very different nature of the respective inventions and problems described in *Rangwalla* and *Pennaz*.

There is no motivation to combine the teachings. *Rangwalla* does not describe a need for an ink composition having enhanced water stability and viscosity.

For at least these reasons, the Examiner has failed to establish in the first instance a *prima facie* case of obviousness over the present claims.

B. The Combination of Rangwalla and Pennaz Does Not Teach or Suggest All Elements of Claims 1-13, 15-26 and 38

Assuming arguendo that *Rangwalla* and *Pennaz* are combinable, that combination fails to teach or suggest the claimed invention. For example, amended claim 1 recites, among other things, that at least a portion of the ink formulation and at least a portion of the lacquer are selected to permit at least some bonding to each other. Amended claim 13 recites, among other things, that at least a portion of the ink formulation and at least a portion of the lacquer are bonded to each other. Amended claim 20 recites, among other things, that at least a portion of at least one first polymer is bonded to at least a portion of at least one second polymer. Amended claim 38 recites, among other things, that at least a portion of the ink formulation and at least a portion of the lacquer are selected to permit at least some bonding to each other.

There is no teaching or suggestion in either *Rangwalla* or *Pennaz*, alone or in combination, of at least the above claim elements. Accordingly, claims 1, 13, 20, 38 and all dependent claims thereon are allowable.

IV. Conclusion

In view of the foregoing remarks, Applicants submit that the pending claims are allowable over the cited references. Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Date: June 19, 2006

By: 

Mike McGurk
Reg. No. 32,045

437008v1